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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,827	02/04/2002	Scott M. Lewit	5785-30	4819

39207 7590 09/16/2004

SACCO & ASSOCIATES, PA  
P.O. BOX 30999  
PALM BEACH GARDENS, FL 33420-0999

EXAMINER

VO, HAI

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/066,827

Applicant(s)

LEWIT ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-27 is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 10 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. The 103 art rejections over Lewit (US 6,497,190) in view of Becker et al (US 5,262,230) are overcome by the evidence of common ownership. Therefore, the rejections are withdrawn. However, upon further consideration, a new double patenting rejection is made in view of US 6,497,190 and Becker et al (US 5,262,230).

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6, 9, 10 and 19-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-21 of U.S. Patent No. 6,497,190 in view of Becker et al (US 5,262,230). Claims 17 and 18 of U.S. Patent No. 6,497,190 disclose a composite part comprising a fabric layer and a foam core. The fabric layer is composed of an outer reinforcing fabric layer, an inner non-woven fabric layer. The foam core is completely enclosed within the fabric layer. Likewise, the outer reinforcing fabric layer secured to the elongated foam core and extending along a first elongated side of the foam core; the outer reinforcing fabric

layer enclosing the inner non-woven fabric layer which is located between the first elongated side of the foam core and the outer reinforcing fabric layer. Claims 17 and 18 of U.S. Patent No. 6,497,190 also suggest that the outer reinforcing fabric layer encloses a second and third elongated side of the foam core, each of said second and third elongated sides adjoining the first elongated side. Claim 19 of U.S. Patent No. 6,497,190 discloses the foam core filling the interstices 11 of the inner non-woven fabric layer without penetrating into the outer reinforcing fabric layer. Likewise, it is readily apparent that the outer reinforcing fabric layer would have the porosity sufficient to permit a predetermined amount of resin to escape from the inner non-woven fabric layer along the elongated length. Claims 17-21 of U.S. Patent No. 6,497,190 do not specifically disclose that the inner non-woven fabric layer made of a three-dimensional plastic mesh. Becker, however, teaches a lightweight composite material for use in the boat construction containing reinforcing fibers in a thermoset matrix in three-dimensional mesh structure (abstract, column 5, lines 1-3, and 42) to provide a composite material with high corrosion resistance, high impact strength, and high tensile strength. Becker discloses the three-dimensional plastic mesh having a porosity of at least 50%, meeting the specific range required by the claims (column 1, lines 15-17). Becker discloses the three-dimensional plastic mesh defines interstices for passage of resin (column 1, lines 10-20). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the inner non-woven fabric layer with the three-dimensional plastic mesh as taught in Becker motivated by the desire

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to provide the composite part having corrosion resistance, high impact strength, and high tensile strength. This is important to the expectation of successfully practicing the invention of U.S. Patent No. 6,497,190 and thus suggesting the modification.

Claims 17-21 of U.S. Patent No. 6,497,190 do not specifically disclose the three-dimensional plastic mesh having substantially less resistance to a flow of resin as compared to the fabric layer and how the resin flows when introduced within the flow channel under pressure. It appears that the composite part of U.S. Patent No. 6,497,190 as modified by Becker meets all the structural limitations and chemistry as required by the claims. The composite part comprises an elongated foam core; one fabric layer secured to the elongated core; and extending along a first elongated side of the foam core, the fabric layer enclosing an elongated channel between the first elongated side of the foam core and the fabric layer. The fabric layer encloses at least a second and third elongated side of the foam core, each of said second and third elongated sides adjoining the first elongated side. The flow channel is made of the three-dimensional plastic mesh. Accordingly, it is the examiner's position that the three-dimensional plastic mesh would inherently substantially have less resistance to a flow of resin as compared to the fabric layer and that the resin would inherently flow along a length of the elongated side when introduced within the flow channel under pressure. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. This is also in line with *In re Spada*, 15 USPQ 2d 1655 (1990), which holds that Products of identical chemical composition can not have mutually exclusive properties.

Claims 17-21 of U.S. Patent No. 6,497,190 do not specifically disclose the fabric tab portions extending from the second and third elongated sides. However, since the composite part of the U.S. Patent No. 6,497,190 as modified by Becker meets all the structural limitations as recited in the claims and useful as a boat hull. Therefore, it is the examiner's position that the fabric tab portions would be inherently present so as to enable the composite part to be laminated into the boat hull construction.

***Allowable Subject Matter***

4. Claims 22-27 are allowed.
5. Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reasons have been stated in the previous Office Action mailed on 03/20/2003.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Hai Vo  
Tech Center 1700